

Appln No. 10/040,977

Amdt date September 28, 2004

Reply to Office action of June 28, 2004

REMARKS/ARGUMENTS

Claims 1-4 and 7-43 now remain pending in this application. Applicants have amended claims 1, 24, 29, 30 and 31, and canceled claims 5 and 6. Applicants have also amended claims 27, 36, 37, 38 and 43 solely to correct minor, inadvertent typographical errors. No new matter is presented. In view of the above amendments and following remarks, Applicants respectfully submit that all of pending claims 1-4 and 7-43, as amended, are in condition for allowance. Accordingly, Applicants respectfully request reconsideration and a timely indication of allowance.

As a preliminary matter, Applicants note that although the Examiner acknowledged consideration of the Information Disclosure Statement submitted April 3, 2003, the Examiner has not yet acknowledged consideration of the Information Disclosure Statement submitted on February 18, 2004. Accordingly, Applicant respectfully requests that the Examiner acknowledge consideration of the February 18, 2004 Information Disclosure Statement, initial each reference cited therein, and return an initialed copy to Applicants with the next correspondence.

In the Office Action dated June 28, 2004, the Examiner rejected claims 2-4, 14-17, 20, 21 and 36-38 under 35 U.S.C. § 112 ¶ 2 as allegedly indefinite. The Examiner cites four cases, *Ex parte Wu*, 10 U.S.P.Q.2d 2031 (B.P.A.I. 1989), *Ex parte Steigerwald*, 131 U.S.P.Q. 74 (B.P.A.I. 1961), *Ex parte Hall*, 83 U.S.P.Q. 38 (B.P.A.I. 1948), and *Ex parte Hasche*, 86 U.S.P.Q. 481 (B.P.A.I. 1949), to support the assertion that the term "about" used to describe ranges in those claims renders the

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claims indefinite. However, none of the cases cited by Examiner supports the conclusion that the term "about" used to describe a range renders a claim indefinite.

In *Ex parte Wu*, the Board of Patent Appeals and Interferences (the "Board") held the use of the term "optionally" to describe an optional element of a claim does not render the claim indefinite. *Ex parte Wu*, 10 U.S.P.Q.2d at 2033. In so holding, the Board noted that in rejecting a claim for indefiniteness, an examiner must "establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claim[]." *Id.* Claims 2-4, 14-17, 20, 21 and 36-38 each set forth a specific range. One of ordinary skill in the art would recognize that the term "about" used to describe the claimed ranges merely represents the deviation inherent in such measurements. As such, use of the term "about" in this context is akin to the "accepted expressions 'up to', 0 to . . . %" [and] 'not more than,' " *id.*, and therefore does not render claims 2-4, 14-17, 20, 21 and 36-38 indefinite. Accordingly, Applicants respectfully request withdrawal of this rejection.

The Examiner also rejected claims 1, 5, 7, 9, 18-21 and 30 under 35 U.S.C. § 102(b) as allegedly anticipated by Dahl, et al. (U.S. Patent No. 5,531,779). However, Applicants have canceled claims 5 and 6 and have amended independent claims 1 and 30 to recite that the electrode assembly is fixedly mounted at the distal end of the catheter body. Dahl neither teaches

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nor suggests such a configuration. Rather Dahl discloses an implantable electrode. Accordingly, Applicants submit that independent claims 1 and 30, and all claims dependent therefrom, including claims 7, 9 and 18-21, are allowable over Dahl.

In addition, the Examiner rejected claims 1-3, 5, 11 and 12 under 35 U.S.C. § 102(b) as allegedly anticipated by Edhag (U.S. Patent No. 5,010,894). However, Applicants have canceled claims 5 and 6 and have amended independent claims 1 and 30 to recite that each spine comprises a flexible wire, at least a portion of which forms the elongated electrode, and that the proximal and distal ends of the flexible wire are covered by a non-conductive covering. Edhag neither teaches nor suggests such a configuration. As such, Applicants submit that independent claims 1 and 30, and all claims dependent therefrom, including claims 11 and 12, are allowable over Edhag.

Also, the Examiner rejected claims 1, 5, 6, 8, 18, 22 and 28 under 35 U.S.C. § 102(b) as allegedly anticipated by McGee, et al. (U.S. Patent No. 5,855,592). However, McGee also fails to teach or suggest the configuration of the spines recited in amended claims 1 and 30, as discussed above with respect to Edhag. Applicants therefore submit that independent claims 1 and 30, and all claims dependent therefrom, including claims 8, 18, 22 and 28, are allowable over McGee.

The Examiner also rejected claim 23 under 35 U.S.C. § 102(b) as allegedly anticipated by Ljungstroem (U.S. Patent No. 5,423,864). Claim 23 depends from claim 18 which depends from claim 1. Ljungstroem also fails to teach or suggest the configuration of the spines recited in amended claims 1 and 30,

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as discussed above. Therefore, Applicants submit that independent claims 1 and 30, and all claims dependent therefrom, including claim 23, are allowable of Ljungstroem.

The Examiner also rejected claims 4 and 13-17 under 35 U.S.C. 103(a) as allegedly unpatentable over Edhag. However, claims 4 and 13-17 each depend from claim 1, which is allowable over Edhag, as discussed above. Claims 4 and 13-17 are therefore also allowable.

Finally, the Examiner allowed claim 43, and indicated that claims 24-27, 29, 31-35 and 39-42 would be allowable if rewritten in independent form. Applicants have amended claim 43 solely to correct a minor, inadvertent typographical error, and have made no substantive amendments to that claim. As such, claim 43 remains allowable. Applicants have rewritten claims 24, 29 and 31 in independent form. These claims are therefore also allowable. Claims 25-27, 32-35 and 39-42 each depend from either of independent claims 24, 29 or 31, and are therefore allowable.

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of pending claims 1-4 and 7-43, as amended, are in condition for allowance. Applicants therefore respectfully request a timely indication of allowance. If there

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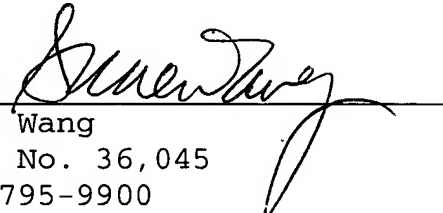
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are any remaining issues that may be addressed by telephone,
Applicants invite the Examiner to contact the undersigned at the
number indicated below.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By


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626/795-9900

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